

ESTTA Tracking number: **ESTTA380593**

Filing date: **11/24/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Affinity Circles, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	111 W. Evelyn Ave., Suite 115 Sunnyvale, CA 94086 UNITED STATES		

Attorney information	Thomas H. Zellerbach & M. Leah Somoano Orrick, Herrington & Sutcliffe LLP 1000 Marsh Road Menlo Park, CA 94025 UNITED STATES ipprosecution@orrick.com, tzellerbach@orrick.com, orapoport@orrick.com, lsomoano@orrick.com, kime@orrick.com Phone:650.614.7400		
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### Applicant Information

Application No	85046948	Publication date	10/26/2010
Opposition Filing Date	11/24/2010	Opposition Period Ends	11/25/2010
Applicant	Choat, Ken R. 62 Masters Circle Pagosa Springs, CO 81147 UNITED STATES		

### Goods/Services Affected by Opposition


Class 045. All goods and services in the class are opposed, namely: Internet-based social networking services
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3700315	Application Date	04/27/2007
Registration Date	10/20/2009	Foreign Priority Date	NONE
Word Mark	INCIRCLE		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 2002/08/30 First Use In Commerce: 2002/08/30  Providing an online information services directory featuring information about and for registered users for an online community for the purpose of social and professional networking, organizing events, and sharing electronic media, namely, images, photos, text, audio</p> <p>Class 042. First use: First Use: 2002/08/30 First Use In Commerce: 2002/08/30  Computer services, namely, creating and hosting an online community for registered users to engage in social and professional networking</p>

Attachments	77977663#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.PDF ( 4 pages )(43168 bytes ) Certificate of Service.PDF ( 1 page )(9072 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thomas H. Zellerbach /
Name	Thomas H. Zellerbach
Date	11/24/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Application Serial No. 85/046,948

Mark: ICIRCLES

Published for Opposition on October 26, 2010

Affinity Circles, Inc.,

Opposer,

-v-

Ken R. Choat, an individual,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Affinity Circles, Inc., a Delaware corporation, with its principal place of business at 111 W. Evelyn Ave., Suite 115, Sunnyvale, California 94086 (hereinafter referred to as “Opposer” or “Opposer Affinity Circles”), believes that it will be damaged by the registration of the above-identified mark “ICIRCLES” (Application Serial No. 85/046,948) (“Application”) on the ground the mark is likely to cause confusion, mistake or to deceive pursuant to 15 U.S.C. § 1052(d) and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer Affinity Circles was incorporated in Delaware on August 5, 2002, with its principal place of business located at 520 San Antonio Road, Suite 100, Mountain View, California 94040.
2. To the best of Opposer’s knowledge, the legal name of the current owner of the Application is Ken R. Choat, an individual of American citizenship domiciled at 62 Masters Circle, Pagosa Springs, Colorado 81147 (hereinafter referred to as “Applicant”).

3. On May 25, 2010, Applicant filed the above-referenced intent-to-use trademark application for the mark ICIRCLES with the U.S. Patent and Trademark Office in connection with “internet-based social networking services” in International Class 045.

4. On October 26, 2010, Applicant’s application for ICIRCLES was published for opposition.

5. Opposer Affinity Circle is the owner of a federal registration for INCIRCLE (Registration No. 3700315, registered on October 20, 2009) used in connection with “providing an online information services directory featuring information about and for registered users for an online community for the purpose of social and professional networking, organizing events, and sharing electronic media, namely, images, photos, text, audio” in International Class 035 and “computer services, namely, creating and hosting an online community for registered users to engage in social and professional networking” in International Class 042. Opposer is also the owner of a federal registration for INCIRCLE (Registration No. 3003878, registered on October 4, 2005) used in connection with “computer software, namely, providing temporary use of on-line non-downloadable computer software for colleges, higher-education institutions, alumni associations, and membership-driven organizations for use in gathering member information, facilitating social networking between members, and in providing on-line directory information” in International Class 042. Opposer has, since at least as early as August 30, 2002, used the mark INCIRCLE in connection with online social and professional networking.

6. Upon information and belief, Applicant has not used the ICIRCLES mark on its services in the United States as evidenced by Applicant’s filing basis of intent-to-use in the subject application. Opposer’s mark therefore has priority over Applicant’s mark insofar as Opposer’s use of its mark and the issuance of registrations for those marks predate Applicant’s filing of his Application.

7. Applicant’s ICIRCLES mark is virtually identical to Opposer’s INCIRCLE mark. Indeed, the only difference between the marks is that Applicant has deleted a

letter between “I” and “C” and made plural the word “circle” in his mark. Such differences are inconsequential.

8. The services associated with Applicant’s ICIRCLES mark and those associated with Opposer’s INCIRCLE mark are highly related.

9. Based upon information and belief both Opposer’s services and Applicant’s services are or will be provided and marketed through similar channels, namely the internet.

10. Opposer has provided its services under the mark INCIRCLE throughout the United States and has developed valuable goodwill with respect to the mark INCIRCLE. By virtue of its efforts and the expenditure of considerable sums for promotional and advertising activities, consumers have come to associate Opposer’s mark with the services provided under the mark, including but not limited to online social and professional networking.

11. In light of the foregoing, consumers are likely to mistakenly assume that Applicant’s services originate from, are sponsored by or are otherwise related to Opposer or vice versa. The similarity between Applicant’s mark and Opposer’s mark and the relatedness of their services are likely to cause confusion, mistake or deception among consumers as to the nature, source and origin of the services.

12. Opposer will be damaged within the meaning of 15 U.S.C. § 1063 if registration is granted for ICIRCLES for the services identified in Application Serial No. 85/046,948 because Opposer has a legitimate commercial interest in the use of that term, common law rights pre-dating Applicant’s rights, and because such registration is likely to cause confusion or mistake or to deceive.

WHEREFORE, Opposer prays that Application Serial No. 85/046,948 be refused registration and that the Board sustain this Opposition.

Opposer hereby appoints the law firm of Orrick, Herrington & Sutcliff LLP, 1000 Marsh Road, Menlo Park, California 94025, telephone number (650) 614-7400, as the address to which all communications are to be directed and hereby appoints each of the following attorneys

associated with said firm, and at the same address, individually and collectively, its attorneys, with full power of substitution and revocation, to prosecute this opposition proceeding and to transact all business in the U.S. Patent and Trademark Office in connection therewith: Thomas H. Zellerbach, M. Leah Somoano, Diana Rutowski and Kristin Cornuelle.

The Commissioner is authorized to charge Deposit Account No. 15-0665 for the \$300 filing fee for this Notice of Opposition

Dated: November 24, 2010

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

/s/ Thomas H. Zellerbach

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In the matter of trademark Application Serial No. 85/046,948

Mark: ICIRCLES

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Ken R. Choat, an individual,

Applicant.

Opposition No. \_\_\_\_\_

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing:

**NOTICE OF OPPOSITION**

has been served on Mr. Ken R. Choat, by mailing said copy on November 24, 2010, via First Class Mail, postage prepaid to:

62 MASTERS CIRCLE

PAGOSA SPRINGS

COLORADO 81147

  
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Olga Rapoport